

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

P24616

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/718,525

Filed

November 24, 2003

First Named Inventor

H. INOUE et al.

Art Unit

1772

Examiner

Chevalier

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 29,027

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

Bruce H. Bernstein, 29,027

Typed or printed name

(703) 716-1191

Telephone number

7/9/07

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below\*.

☒

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Hiroharu INOUE et al.	Group Art Unit : 1772
Appln. No	:	10/718,525	Examiner : Chevalier
Filed	:	November 24, 2003	Confirmation No. 1953
For	:	POLY (PHENYLENE ETHER) RESIN COMPOSITION, PREREG, AND LAMINATED SHEET	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop **AF**  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

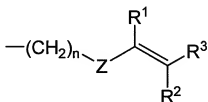
This request is being filed concurrently with a Notice of Appeal and in response to the Final Office Action dated March 3, 2007. Reconsideration and withdrawal of the rejection under 35 U.S.C. 112, first paragraph, is requested in view of the following remarks.

**Final Rejection**

The Examiner asserts claims 2-18, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The rejection contends that claim 21 contains the limitation “Z is a para- or meta phenylene” and the specification only has support for para- or meta- ethenylbenzyl, not the broader para- or meta- phenylene, and therefore the limitation is asserted to constitute new matter. Applicants respectfully disagree, and submit that Applicants’ originally filed application renders it clear to one having ordinary skill in the art that Applicants were in possession of the claimed subject matter at the time of filing the application.

### Applicants' Reply Pointing Out Clear Error In Rejection

Applicants submit that independent claim 21, includes amongst other recitations therein, a terminal group of the polyethylene ether represented by

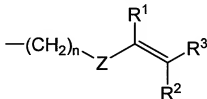


Independent claim 21 further defines that when Z is a para- or meta-phenylene group, n is 1.

Thus, as defined in claim 21, when Z is a para- or meta-phenylene group and n is 1, the formula  $-\text{CH}_2-\text{Z}-$ , corresponds to a para- or meta-benzyl group, which forms a terminal group named as the para- or meta-ethenylbenzyl group when the benzyl group binds to an ethenyl group, i.e.,  $-\text{C}(\text{R}_1)=\text{CR}_2(\text{R}_3)$ .

This feature included in Applicants' independent claim 21, and the claims dependent therefrom, is supported by Applicants' originally filed application, including the disclosure at page 9, lines 20-24, of Applicants' originally filed specification (with typographical corrections made in the Amendment filed June 8, 2006), in which the above-noted terminal structure of the polyphenylene ether is described as follows:

In the following partial structure of PPE (I), it is preferable that Z is a phenylene group and n is 1 (i.e., benzyl derivative), or that Z is an oxygen atom and n is 2, more preferably a *p*-ethenylbenzyl, *m*-ethenylbenzyl, or ethenyloxyethyl group.



Applicants submit that one having ordinary skill in the art reading Applicants' originally filed disclosure would readily understand that the preferred embodiment of the terminal structure is represented by the formula,  $-\text{CH}_2-\text{C}_6\text{H}_4$ -(ethenyl group), in which a methylene group ( $\text{CH}_2$ ) constituting the benzyl derivative ( $-\text{CH}_2-\text{C}_6\text{H}_4-$ ) and an ethenyl group are mutually placed to a para- or meta-position around a phenylene group ( $-\text{C}_6\text{H}_4-$ ).

In other words, in the above-shown general structure, since Z is a phenylene group and  $n=1$ , (i.e., benzyl derivative), it is readily understood by one having ordinary skill in the art that the para- or meta-ethenylbenzyl group is constituted from the para- or meta-phenylene group as Z, around which the  $\text{CH}_2$  group (i.e.,  $n=1$ ) is put in the para or meta-position relative to the ethenyl group.

Therefore, one having ordinary skill in the art would readily recognize from Applicants' originally filed application that the preferable grouping of the benzyl derivative (Z is a phenylene group and  $n=1$ ) is a para- or meta-phenylene group, and the ethenyl group is a preferred group.

In the instant situation, it is readily seen that Applicants were in possession of para- and meta-phenylene groups, and especially benzyl derivatives thereof at the time of filing their application. It is therefore evident that at the time of filing of Applicants' application, Applicants were in possession of the claimed subject matter, and a written description rejection is without sufficient basis. In this regard, Applicants note that if a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972).

The Examiner appears to be concerned that the specification does not explicitly include whether all phenylene groups are ortho, meta or para. In contrast with this concern, Applicants

note that one having ordinary skill in the art would readily recognize from Applicants' originally filed application that the preferable grouping of the benzyl derivative (Z is a phenylene group and  $n=1$ ) is a para- or meta-phenylene group, with the ethenyl group being preferred. Thus, one having ordinary skill in the art would understand that Applicants, at the time of filing of their application, were in possession of a benzyl derivative (Z is a phenylene group and  $n=1$ ) at least for para- and meta- positioning. Therefore, the claimed subject matter does not constitute new matter, and is based upon an adequate written description.

Accordingly, the claimed subject matter recited in independent claim 21 and the claims dependent therefrom is fully supported by Applicants' originally filed application, and does not constitute new matter. Thus, the rejection is clearly erroneous and should be withdrawn, and the Notices of Allowance and Allowability should be mailed.

Please charge any required fee for entry and/or consideration of this paper to Deposit Account No. 19-0089.

### CONCLUSION

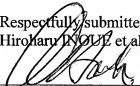
Applicants respectfully request that the Examiner's decision to finally reject claims 2-18, 21 and 22 be withdrawn and the application be returned to the Examiner for allowance.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow each of the pending claims.

Should there be any questions regarding this application, please contact the undersigned at the below-listed telephone number.

July 9, 2007  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191

Respectfully submitted,  
Hirohisa INOUE et al.

  
Bruce H. Bernstein  
Reg. No. 29,027

**Arnold Turk**  
**Reg. No. 33094**